

DOCKET NO: 296895US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
FRANK-MARTIN PETRAT, ET AL. :
SERIAL NO: 10/594,995 : ATTN: LICENSING AND REVIEW
FILED: JULY 26, 2007 :
FOR: NANOSCALAR SILICON :
PARTICLES IN NEGATIVE ELECTRODE
MATERIALS FOR USE IN LITHIUM-ION
BATTERIES

DECLARATION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

I, Dr. Gerhard Olbricht, declare that:

1. I am patent counsel in the Intellectual Property Department of ~~Evonik Degussa GmbH, located in Marl, Germany.~~ Evonik Industries AG (until July 31, 2011: Evonik Degussa GmbH), located in Marl, Germany.

2. I am the supervisor of in-house patent counsel responsible for directing the filing and prosecution of the above-identified U.S. patent application of Dr. Frank-Martin PETRAT, et al, entitled "Nanoscalar Silicon Particles In Negative Electrode Materials For Use In Lithium-Ion Batteries," filed on July 26, 2007. This application was accorded patent application number 10/594,995, and is a 35 U.S.C. § 371 National Stage patent application of International patent application PCT/EP2005/051238, filed on March 17, 2005, which claims priority to German patent application DE 102004016766.4-45, filed on April 1, 2004.

3. Under my supervision, the subject matter disclosed in the above-identified U.S. patent application was filed in the following countries on the dates specified:

Country and/or Receiving Office	Filing Date
Germany	April 1, 2004
China	November 30, 2006
Europe	March 17, 2005
International Bureau of the WIPO	March 17, 2005
Japan	October 2, 2006
Taiwan	March 31, 2005
India	September 28, 2006
South Korea	September 29, 2006
United States	July 26, 2007

4. The above-identified receiving offices are the only national and international receiving offices in which the subject matter disclosed in the above-identified U.S. patent application has previously been filed.

5. The subject matter filed in the above-identified non-U.S. countries is identical to that disclosed in U.S. patent application number 10/594,995.

6. The subject matter disclosed in the above-identified U.S. patent application was neither under a secrecy order at the time that it was filed abroad, nor currently under a secrecy order. In addition, it is my opinion that the application does not relate to matters of national security or defense, etc., and that such a secrecy order is not required.

7. The above-identified U.S. patent application lists an inventor, namely David Lee, that may have contributed to at least part of the claimed subject matter of this application while present in the U.S.

8. At the time of filing the subject matter in Germany, China, Europe, India, Japan, Taiwan, the International Bureau of the WIPO, and South Korea, Evonik Degussa GmbH in-house patent counsel was unaware that David Lee may have contributed to at least part of the claimed subject matter of this application while present in the U.S. since the inventorship had not yet been determined prior to filing in the above-identified foreign countries. The inventorship information was not needed at the time of filing in these foreign countries.

9. Since the Evonik Degussa GmbH in-house patent counsel was unaware at the time of filing the patent application in the foreign countries that a researcher may have contributed to at least part of the claimed subject matter of this application while present in the U.S., the above-identified non-U.S. patent applications were filed without a U.S. foreign filing license through error and without deceptive intent.

10. On July 13, 2011, the Intellectual Property Department of Evonik Degussa GmbH received correspondence from their U.S. legal representatives indicating how the requirements set forth in 35 U.S.C. § 184 and 37 C.F.R. § 5.25 would apply to this case in the event that a researcher contributed to at least part of the claimed subject matter of this application while present in the U.S.

11. Upon discovering on July 13, 2011, that a researcher may have contributed to at least part of the claimed subject matter of this application while present in the U.S. and becoming privy to the requirements for obtaining a retroactive foreign filing license as set forth in 35 U.S.C. § 184 and 37 C.F.R. § 5.25, my colleague Dr. Geipel within the Intellectual Property Department of Evonik Degussa GmbH diligently instructed our U.S. legal representatives on July 14, 2011 to initiate a request for a retroactive foreign filing license.

Further investigation of this matter has resulted in the present request for a retroactive foreign filing license.

12. The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

gpa. Olbricht
Dr. Gerhard Olbricht

5. Sept. 2011
Date